

Attorney Docket No. P11303-US1  
Customer Number 27045

### **REMARKS/ARGUMENTS**

#### **1.) Claim Amendments**

Claims 1-38 and 40-41 are pending in the application.

#### **2.) Claim Rejections – 35 U.S.C. § 103(a)**

##### **Claims 1-28, 31-38 and 40-41:**

The Examiner rejected claims 1-38 and 40-41 under 35 U.S.C. § 103(a) as being unpatentable over Lintulampi (US 6,377,804) in view of Rinne, et al. (US 2001/0046863). The Applicant respectfully traverses this rejection.

The Office Action states that Rinne discloses "simultaneous communications" in paragraph 102. The Applicant respectfully disagrees with this characterization of Rinne. For discussion purposes, paragraph 102 of Rinne is reproduced below:

Used with a CDMA-type radio network, which facilitates the combining of signals from multiple base stations, or macrodiversity combining, the arrangement according to the invention is characterised by some special features. Macrodiversity combining employs multiple simultaneous connections, first, between the terminal and base station sectors and, second, between the terminal and individual base stations. On the uplink path the terminal uses one signal and one spread code which is received at several base stations. Alternatively, the terminal may use one signal with several spread codes received at several base stations. The final signal is the result of macrodiversity combination. In the downlink direction, several base stations transmit one and the same signal spread using different spread codes to a terminal that performs the macrodiversity combining. The signal connections that provide sufficient signal strength at agreed power levels belong to the so-called active set.

In contrast, the present invention defines "communications" as:

Examples of the communication include telephone calls, faxes, downloading of data or uploading of data (file transfer). . . According to the invention, communication includes connections as well as connectionless transfer of information such as Short Messaging Service (SMS). Future wireless scenarios for wideband wireless multimedia services can comprise: interactive news delivery (voice, video, E-mail, graphics), interactive e-mail (text, graphics, video clips), interactive audio (CD-quality voice, video, graphics), video conferencing, web browsing,

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dynamic Internet-based games, downloading large files from intranets or position/location-dependent "push" info. (Specification, page 2, line 20 to page 3, line 4).

As the Examiner is aware, it is well established that the inventor can be his own lexicographer. As the MPEP states in section 2106(II)(C):

Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S. , 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings.")

Thus, it is respectfully suggested that the definitions of "communication" as defined in the specification, be used to properly determine the meaning of terms used in the claims. Rinne only discusses the CDMA concept of spread spectrum technology. In this transmission technique, the frequency spectrum of a data-signal is spread using a code uncorrelated with that signal between base stations and mobile units. There is no discussion of in either Lintulampi nor Rinne regarding the concept of simultaneous "communications" as this term is used in the claims and defined by the specification.

In order to establish a *prima facie* case of obviousness, the cited references must collectively disclose all of the elements of the rejected claims. As shown above, Rinne does not disclose simultaneous communications as defined by the Applicant's specification. Additionally, Lintulampi, does not make up for the shortcomings of Rinne. Thus, not all of claim elements are taught by the combination of Rinne and Lintulampi.

Assuming *arguendo* that the term "communication" could somehow be found in Rinne, there is still no motivation for combining the references.

The examiner states "it would have been obvious to modify Lintulampi with the above teaching of Rinne" (i.e., CDMA spread spectrum technology) "in order to provide

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tunnels between two networks by determining a new route between the anchor controller and a new active radio network controller so that the previous active radio network control is by passed (as suggested by Rinne, see paragraphs 029 and 072). The motivation of "determining of a new route" as suggested by the examiner has nothing to do with the mention of CDMA spread spectrum technology discussed in paragraph 102 of Rinne. As anyone skilled in the art would realize, spread spectrum technology could not possibly be used to "provide tunnels between two networks by determining a new route between the anchor controller and a new active radio network controller so that the previous active radio network control is by passed."

All of the cited passages in Rinne deal with signals between the mobile unit and the base stations or RNCs. Nothing in Rinne deals with signals going into and out of the core network – as would have to be the situation with a "communication" as used in the present claims. Thus, there is no motivation for combining the references.

According to MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Obviousness cannot be established by combining references "without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." MPEP 2144, quoting from *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993). "Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence." See *Dembiczak*, 50 USPQ2d, 1614, (Fed. Cir. 1999).

Thus, the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated

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on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

The case law makes it clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *Id.* It is respectfully submitted that the only way Lintulampi and Rinne could be pieced together to defeat patentability is indeed to use Applicant's disclosure as a blueprint.

#### Claims 29-30:

In the last Office Action, the Applicant respectfully traversed the use of "official notice" and requested that the examiner "provide such supporting facts and evidence in the form of an affidavit, so that if necessary, the Applicant may explain the reference." Contrary to the PTO's regulations, the examiner completely ignored this request.

The Applicant again requests that the Examiner respond to this request AND to remove the finality of this Office Action so that the Applicant has an opportunity to respond to the examiner's affidavit.

### CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

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The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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